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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
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EXAMINER

HERNANDEZ, NELSON D

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,687	Applicant(s) HEILES, LAINYE E.	
	Examiner Nelson D. Hernandez	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-22, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 19 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim **1, 2, 4-15, 17, 18** and **20** are rejected under 35 U.S.C. 102(e) as being anticipated by Ogawa, US Patent 6,603,506.

Regarding claim **1**, Ogawa discloses a digital camera (Figs. 1: 10 and 13: 10) comprising: a picture-taking mechanism (Fig. 1: 10a) to take pictures to generate image files (Col. 3, lines 40-53) corresponding to the pictures; and, a contact sheet generation mechanism (Fig. 1: 10m) to generate one or more contact sheet files, each contact sheet file including a plurality of thumbnail images, each thumbnail image corresponding to one of the image files (Fig. 5, col. 3, lines 8-33; col. 4, line 54 – col. 5, line 29; col. 5, lines 58-63).

Regarding claim **2**, Ogawa discloses that the contact sheet generation mechanism dynamically generates the one or more contact sheet files as the pictures are taken by the picture-taking mechanism (Col. 7, lines 1-11).

Regarding claim 4, Ogawa discloses that the contact sheet generation mechanism generates the one or more contact sheet files upon user command (Col. 4, lines 54-67; col. 5, lines 1-28).

Regarding claim 5, Ogawa discloses that the contact sheet generation mechanism generates the one or more contact sheet files when the image files are uploaded to another device (Col. 4, lines 54-67; col. 5, lines 1-28).

Regarding claim 6, this claim covers several structures as alternatives. When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001).

Ogawa discloses that each contact sheet file includes for each thumbnail image of the plurality of thumbnail images a file name of the image file corresponding to the thumbnail image (Col. 5, lines 1-13).

Regarding claim 7, Ogawa discloses that the image files are generated according to a file format, and the one or more contact sheet files are generated according to the file format (Col. 1, lines 40-44; col. 5, lines 51-57; col. 7, lines 44-51; col. 8, lines 8, lines 8-27).

Regarding claim 8, Ogawa discloses an uploading mechanism to selectively upload at least some of the image files and at least some of the one or more contact sheet files to another device (Col. 4, lines 54-67; col. 5, lines 1-28).

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Regarding claim 9, Ogawa discloses a digital camera comprising: a picture-taking mechanism (Fig. 1: 10a) to take pictures by generating image files (Col. 3, lines 40-53) corresponding to the pictures; and, a contact sheet generation mechanism (Fig. 1: 10m) to generate one or more persistent additional image files, each additional image file including a plurality of reduced-in-size images, each reduced-in-size image corresponding to one of the image files generated by the picture-taking mechanism (Fig. 5, col. 3, lines 8-33; col. 4, lines 54-67; col. 5, lines 1-63).

Regarding claim 10, Ogawa inherently discloses that each image file generated by the picture-taking mechanism and each persistent additional image file generated by the contact sheet generation mechanism has a same size by teaching that the contact sheet generation mechanism (Fig. 1:10m) generates a sample table data having corresponding to the resolution obtained from the printer-type management table and that the sample-table generating module 10m loads the respective image data stored in the external storage device, and performs interpolation or thinning on the loaded data in accordance with the determined image size (Col. 5, lines 1-13).

Regarding claim 11, Ogawa discloses that the contact sheet generation mechanism dynamically generates the one or more persistent additional image files as the pictures are taken by the picture-taking mechanism (Col. 7, lines 1-11).

Regarding claim 12, Ogawa discloses that the contact sheet generation mechanism generates the one or more persistent additional image files in response to an event (Col. 7, lines 1-11; see also col. 4, lines 54-67).

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Regarding claim **13**, Ogawa discloses that the event comprises one of: user command, and uploading of the image files to another device (Col. 3, lines 40-53; col. 4, lines 54-67; col. 5, lines 1-28, col. 7, lines 1-11).

Regarding claim **14**, Ogawa discloses a digital camera (Figs. 1: 10 and 13: 10) comprising: means for generating image files (Col. 3, lines 40-53) corresponding to pictures taken by the digital camera; and, means for generating one or more contact sheet files (Fig. 1: 10m), each contact sheet file including a plurality of thumbnail images, each thumbnail image corresponding to one of the image files (Fig. 5, col. 3, lines 8-33; col. 4, lines 54-67; col. 5, lines 1-63).

Regarding claim **15**, Ogawa discloses that the means for generating the one or more contact sheet files further is for dynamically updating the one or more contact sheet files as the pictures are taken by the digital camera (Col. 4, lines 54-67; col. 5, lines 1-28, col. 7, lines 1-11).

Regarding claim **17**, Ogawa discloses a method for performance by a digital camera (Figs. 1: 10 and 13: 10) comprising: generating image files (Col. 3, lines 40-53) corresponding to pictures taken with the digital camera; and, generating one or more contact sheet files (Col. 4, lines 54-67; col. 5, lines 1-57), each contact sheet file including a plurality of thumbnail images, each thumbnail image corresponding to one of the image files (See fig. 5) (Fig. 5, col. 3, lines 8-33; col. 4, lines 54-67; col. 5, lines 1-63).

Regarding claim **18**, Ogawa discloses generating an additional image file corresponding to an additional picture taken with the digital camera; and, updating a

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contact sheet file of the one or more contact sheet files to include a thumbnail image corresponding to the additional image file (Col. 4, lines 54-67; col. 5, lines 1-28, col. 7, lines 1-11).

Regarding claim **20**, Ogawa discloses generating an additional image file and updating a current contact sheet file of the one or more contact sheet files to include a thumbnail image corresponding to the additional image file for each of an additional number of pictures taken with the digital camera (Col. 4, lines 54-67; col. 5, lines 1-28, col. 7, lines 1-11).

3. Claim **21**, **22**, **24** and **25** are rejected under 35 U.S.C. 102(e) as being anticipated by Aizawa, US 2002/0063781 A1.

Regarding claim **21**, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. The claim preamble must be read in the context of the entire claim. Therefore "for performance by a digital camera" was not considered as a limitation since is stated as an intended use in the preamble. See MPEP § 2111.02.

Aizawa discloses a method comprising; removing an image file corresponding to a picture taken with the digital camera; and, updating a contact sheet file (See fig. 2: 202) to remove a thumbnail image corresponding to the image file from the contact sheet file, the contact sheet file originally including at least one thumbnail image

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including the thumbnail image corresponding to the image file (Page 4, ¶ 0063 - ¶ 0069).

Regarding claim **22**, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. The claim preamble must be read in the context of the entire claim. Therefore "for performance by a digital camera" was not considered as a limitation since is stated as an intended use in the preamble. See MPEP § 2111.02.

Aizawa discloses a method comprising; removing an indicated image file selected from a plurality of image files corresponding to pictures taken with a digital camera (Fig. 1: 100); and, updating one or more contact sheet files (See fig. 2: 202) including the contact sheet file previously updated to remove a thumbnail image corresponding to the indicated image file from the one or more contact sheet files (Page 4, ¶ 0063 - ¶ 0069).

Regarding claim **24**, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. The claim preamble must be read in the context

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of the entire claim. Therefore "for execution by a digital camera" was not considered as a limitation since is stated as an intended use in the preamble. See MPEP § 2111.02.

Aizawa discloses a computer-readable medium having instructions stored comprising: a first set of instructions for generating first image files corresponding to pictures taken with a digital camera (Fig. 1: 100); a second set of instructions for generating one or more second image files, each second image file including a plurality of reduced-in-size images (See fig. 2: 202), each reduced-in-size image corresponding to one of the first image files (Page 4, ¶ 0063 - ¶ 0069).

Regarding claim 25, Aizawa discloses a third set of instructions for uploading the first image files and the one or more second image files to another device (Page 4, ¶ 0068).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa, US Patent 6,603,506 in view of Aizawa, US 2002/0063781 A1.

Regarding claim 3, Ogawa does not explicitly disclose that the contact sheet generation mechanism further dynamically generates the one or more contact sheet files as the image files are selectively removed by a user of the digital camera.

However, Aizawa teaches a digital information system wherein a digital camera (Fig. 1: 100) connected to a PC (Fig. 1: 101) via USB, wherein the PC displays the image data collected by the digital camera as an image table using thumbnails (See fig. 2: 202), and in the event where the user remove image data from the digital camera, the camera sends an update signal to the PC indicating that a change has been made in the image data in the digital camera (Page 4, ¶ 0063 - ¶ 0069).

Therefore, taking the combined teaching of Ogawa in view of Aizawa as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital camera in Ogawa by updating the image data in the contact sheet when the user removes image data form the digital camera. The motivation to do so would help the digital camera to create contact sheet with the actual or updated information in the digital camera after any change (i.e. deletion of image data) made by the user as suggested by Aizawa (Page 4, ¶ 0063).

Regarding claim 16, the combination of Ogawa in view of Aizawa teaches the means for generating the one or more contact sheet files further is for dynamically updating the one or more contact sheet files as at least some of the image files are deleted from the digital camera as in claim 3. Therefore, grounds for rejecting claim 3 apply here.

Allowable Subject Matter

6. Claims 19 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernandez whose telephone number is (703) 305-8717. The examiner can normally be reached on 8:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R. Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson D. Hernandez
Examiner
Art Unit 2612

NDHH
November 22, 2004


TUAN HO
PRIMARY EXAMINER